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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,098	02/17/2004	David J. Allard	BOC9-2003-0087 (458)	9891
40987 7590 11/25/2009 Novak Druce + Quigg LLP CityPlace Tower, 525 Okeechobee Blvd. Fifteenth-Floor WEST PALM BEACH, FL 33401				
EXAMINER				
RANGREU, SHEETAL				
ART UNIT		PAPER NUMBER		
3686				
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11/25/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/780,098

Applicant(s)

ALLARD ET AL.

Examiner

SHEETAL R. RANGREJ

Art Unit

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-4, 16-18, 20, 22-24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 16-18, 20, 22-24, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Prosecution History Summary

1. Claims 2, 5-15, 19, 21, and 25 are cancelled.
2. Claims 1, 3, 20, 22, 24, and 26-27 are amended.
3. Claims 1, 3-4, 16-18, 20, and 22-27 are now pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker (6,988,075; hereinafter Hacker) in view of Kenneth D Mandl, Peter Szolovits, Isaac S Kohane, David Markwell, and Rhona MacDonald **Public standards and patients' control: how to keep electronic medical records accessible but private • Commentary: Open approaches to electronic patient records • Commentary: A patient's viewpoint** BMJ, Feb 2001; 322: 283 – 287 (herein after Mandl).
6. As per claim 1, Hacker discloses a computer-implemented method of permitting controlled access to medical information comprising:
 - (1) supplying medical information of the patient to a central repository by the patient and any medical providers who have treated the patient (Hacker: col. 7, lines 21-27);

(2) storing and maintaining the medical information of the patient in the central repository (Hacker: col. 7, lines 21-27);

(3) accessing the medical information by the patient from an access device using a unique patient identifier and a patient PIN (Hacker: col. 7, lines 56-66).

(3) assigning each authorized user with a unique authorized user ID (Hacker: col. 7, 43-66) and an authorized user PIN (Hacker: col. 7, 43-50; i.e. alphanumeric passphrases; col. 7, 60-66) and tracking and notifying the patient of an identity of a user who accessed the medical information, what was accessed by the user, and when the user accessed the information (Hacker: col. 7, 66-col. 8, 3). Although Hacker does not explicitly teach who accessed the medical information, it is obvious that who accessed the medical information is a pertinent information and the prior art suggests providing the information of who accessed the medical information.

Hacker does not explicitly teach controlling by the patient an authorization and a scope of access to the medical information by modifying an access control list within the patient's profile when the patient is connected to the central repository; and wherein the access control list lists each authorized user and the assigned role of each authorized user, wherein the scope of access includes which items of medical information are available to an assigned role and how that information will be viewed.

Mandl teaches:

(3) controlling by the patient an authorization and a scope of access to the medical information by modifying an access control list within the patient's profile when the patient is connected to the central repository (Mandl: p. 284, section Confidentiality).

wherein the access control list lists each authorized user and the assigned role of each authorized user, wherein the scope of access includes which items of medical information are available to an assigned role and how that information will be viewed (**Mandl: p. 284, section Confidentiality**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings with the motivation of providing a user with managing their own health record and providing a user with a secure data repository of their own medical record (Mandl).

7. As per claim 3, Hacker discloses the method of claim 1, wherein the access device is controlled using a universally unique identifier (**Hacker: col. 7, lines 42-63**).
8. As per claim 4, Hacker discloses the method of claim 1, wherein said controlling step is overridden by a registered emergency provider (**Hacker: col. 7, lines 66-67**).
9. As per claims **20 and 22-23**, it is an article of manufacture claim which repeats the same limitations of claims **1 and 3-4**, the corresponding method claim, as a collection of executable instructions stored on machine readable media as opposed to a series of process steps. Since the teachings of **Hacker and Mandl** disclose the underlying process steps that constitute the method of claims **1 and 3-4**, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claims **20 and 22-23**, are rejected for the same reasons given above for claims **1 and 3-4**.
10. As per claims **24 and 26-27**, they are system claims which repeat the same limitations of claims **1 and 3-4**, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of **Hacker and Mandl** disclose the underlying process steps that constitute the methods of claims **1 and 3-4**, it is respectfully submitted that

they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims **24 and 26-27** are rejected for the same reasons given above for claims **1 and 3-4**.

11. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker (6,988,075; hereinafter Hacker) in view of Kenneth D Mandl, Peter Szolovits, Isaac S Kohane, David Markwell, and Rhona MacDonald and further in view of Felsher (2002/0010679; hereinafter Felsher).

12. As per claim 16, Hacker and Mandl disclose the method of claim 1, but do not teach wherein the patient is compensated for permitting some of the medical information to be available and used by a research institution.

Felsher teaches wherein the patient is compensated for permitting some of the medical information to be available and used by a research institution (**Felsher: para. 310**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings with the motivation of providing a medical history that may be of critical importance to the future of healthcare (**Felsher: para. 7**) and the need for privacy and security of a patient's information (**Felsher: para. 17**).

13. As per claim 17, Hacker and Mandl disclose the method of claim 1, but do not teach wherein during a doctor visit the patient provides access to the medical information for a time period long enough to support the visit at which point the access times out.

Felsher teaches wherein during a doctor visit the patient provides access to the medical information for a time period long enough to support the visit at which point the access times out (**Felsher: para. 354**).

The motivation to combine the teachings is the same as claim 16.

14. As per claim 18, Hacker and Snowden disclose the method of claim 1, but do not teach wherein access to the patient's medical information expires when a physician logs into another room/appointment.

Felsher teaches wherein access to the patient's medical information expires when a physician logs into another room/appointment (**Felsher: para. 359; i.e. second communication session**).

The motivation to combine the teachings is the same as claim 16.

Response to Arguments

15. Applicant's arguments filed for claims 1, 3-4, 16-18, 20, and 22-27 have been fully considered but they are not persuasive.

16. Applicant argues that Hacker does not teach or suggest assigning each user with a unique ID and pin. Examiner disagrees with the applicant and reiterates that Hacker discloses a system having a unique access identification means (i.e. unique ID) and also giving a pass phrase to access the system (i.e. pin), therefore providing each authorized user with an ID and a PIN. Hacker teaches providing the provider with appropriate means for input of the unique access identification for patient identification and access along with unique pass phrases (i.e. pin) to access the patient information (Hacker: col. 7, 60-66).

17. Applicant argues that Mandl does not suggest using an access control list as the mechanism for controlling access. In response to Applicant's argument, **Examiner disagrees**. Mandl discloses the patient having preferences about different parts of his/her medical history by

providing authorization independently; furthermore teachings that patients grant different access rights to different providers based on their role and on the particular individual (Mandl: p. 284; section Confidentiality). According to the Applicant's specification, an example of an access control list could be providing access to parties based upon their assigned role (para. 23).

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571) 270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. R. R./
Examiner, Art Unit 3686
November 20, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686